

III. REMARKS

Status of the Claims

Claim 12 is amended. Claims 12-16 are presented for reconsideration.

Summary of the Office Action

Claims 12 - 16 rejected under 35USC103(a) as being unpatentable over the cited reference Gilham, U.S. Patent No. 4,934,846 in view of the teaching of Lee et al, U.S. Patent No. 5,377,264. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

The claim amendments submitted herewith are presented after final rejection for the purpose of removing the Examiner's objection and placing the claims in condition for allowance or, in the alternative, in better condition for appeal. The Examiner is requested to exercise his discretion and enter these amendments.

Summary of the Invention

Claim 12 of this application, as amended, describes a unique key circuit element embodied in an ASIC for portable use in association with a host computer. In particular security checking means are provided to enable the user to access memory in the host computer for the purpose of a postal transaction. The circuit includes a time out circuit which controls the time in which access to the memory is permitted. A circuit of this type is not disclosed in the cited references either alone or in combination.

Discussion of the Cited References

The reference Gilham described a franking machine which utilizes encryption when printing postal indicia. The encrypted code is incorporated in a label by use of a bar code or other readable medium. The postal worker obtains the encrypted data or message by reading or scanning the label and decrypting the code. Please refer to column 4, lines 34-50 of Gilham. The only pertinent part of this disclosure is that it indicates that a franking machine can use encryption.

It is clear, referring to claims 12-16 that there are many elements missing from this disclosure. The main features of Gilham involve control of the printing of postal indicia within a franking machine. During the printing operation of the franking machine, a machine readable portion of the indicia is read and compared for security purposes prior to printing a visible portion of the indicia. This concerns the internal operation of the franking machine. The features of the subject invention involve access to memory in a host computer in the process of indicia creation. The device of this invention is not intended for stand alone operation (see page 6, lines 15-17 of the subject application).

Newly cited reference, Lee, et al, is relied upon by the Examiner for teaching a timing circuit. The device of Lee is a microcontroller system that includes an ASIC 15, the system communicates with the ASIC and other components such as non-volatile memories that are part of the control of a postal meter mailing machine (see column 3, lines 4-21). The particular features of this system are directed to the input side of security controller 400 (see column 3, lines 44-51). The Examiner cites claim 5 and claim 8 as disclosing a time out circuit. Although these claims recite a time-out signal, they

are in the context the parent claim 1 which is restricted to the process of writing encryption code to memory. This is further described at column 5, lines 4-10.

Combining the teachings of Gilham and Lee, the Examiner concludes:

"It would have been obvious to person of ordinary skill in the art at the time invention was made to employ a time-out circuit as taught by Lee with postage meter device disclosed in Gilham so that postal security device does not run continuously so that each transaction is recorded and terminated so that unauthorized attempt to violate the device is prevented."

There is no support for this statement in the cited references, the security process in Gilham refers to the printing cycle, the cited time-out circuit of Lee is operable during the entering of encryption code. There is no need for a time-out function with respect to the indicia checking of Gilham. There is no question in either instance with regard to the risk of continuous running of either device. It is only the subject application which discloses the risk of prolonged memory access.

The Issue of Obviousness

According to basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the references must be viewed without the benefit of hindsight. (See MPEP sections 706.02(a) and 2141. Applicant submits that the modification of the teachings of Gilham and Lee in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art. There is no

indication that a time-out circuit would be of any use in the printing function of Gilham.

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

None of the cited references either individually or collectively render obvious the postal security device described in claims 12-16.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested.

Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.